



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/357,675	07/20/99	CROCE	CRO01.NF001

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HM22/0124

EXAMINER
SHUKLA, R

ART UNIT	PAPER NUMBER
1632	4

DATE MAILED: 01/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/357,675

Applicant(s)

Croce CM

Examiner

Ram Shukla

Group Art Unit

1632



☐ Responsive to communication(s) filed on 10-22-99

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-16 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Application/Control Number:09/357,675

Art Unit: 1632

DETAILED ACTION

1. Claims 1-16 are pending in the instant application.

2. Notice To Comply With The Sequence Rules

The communication filed 10-27-99 is not fully responsive to the communication mailed 9-27-99 for the reason(s) set forth on the attached Notice To Comply With The Sequence Rules or CRF Diskette Problem Report.

Election/Restriction

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3 and 10-16, drawn to a nucleic acid and methods of gene therapy using such, classified in class 514, subclass 44.
- II. Claims 4-6 and 13-14, drawn to a protein and uses thereof, classified in class 530, subclass 350.
- III. Claims 7-9, drawn to antibodies, classified in class 530, subclass 350.

4. Claims 13-14 are generic to inventions of groups I and II. Should any of these groups be elected, claims 13-14 will be examined to the extent they encompass elected invention.

5. The inventions are distinct, each from the other because of the following reasons:

The inventions of the groups I-III are drawn to different compositions and their uses. The compositions of groups I-III have materially different composition and have different physical and chemical characteristics and also have different utilities. For example, a nucleic acid has different physical and chemical properties compared to those of a protein or an antibody. Although, a protein and an antibody, both are polypeptides, reactivity of an antibody may depends on the part of a protein used for producing antibody. Additionally, a nucleic acid can be used as probes for identifying new sequences or for gene therapy. On the other hand a protein can be used for in vitro assays or for producing antibodies. Therefore, the analysis of the three compositions will require separate searches, for example, in the non-patent literature.

6. Because these inventions are distinct for the reasons given above, have acquired a

Application/Control Number: 09/357,675

Art Unit: 1632

separate status in the art shown by their different classification and their recognized divergent subject matter, and because each invention requires a separate, non-coextensive search, restriction for examination purposes as indicated is proper.

7. During a telephone conversation with Mr. Clifford Weber on 12-27-99 a provisional election was made with traverse to prosecute the invention of group I, claims 1-3 and 10-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 4-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ram R. Shukla whose telephone number is (703) 305-1677. The examiner can normally be reached on Monday through Thursday and every other Friday from 8:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jasmine Chambers, can be reached on (703) 308-2035. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-0196.

Ram R. Shukla, Ph.D.

Jasmine C. Chambers
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